

REMARKS

Claims 1-5, 7, 8 and 10-11 are pending. By this Amendment, the specification is amended to provide proper antecedent basis and as suggested by the Examiner. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to an objection raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. Formal Matters

The Office Action objects to the specification for failing to provide proper antecedent basis for the claimed subject matter. In particular, the feature of the "height of the adhesive over the step portion" as recited in claims 1, 4, 7 and 10. Accordingly, Applicants have amended the specification to include feature that the thin layer of the adhesive in the peripheral region is less than the height of the microlenses. Thus, withdrawal of the objection is respectfully requested.

II. The Claims Define Patentable Subject Matter

The Office Action rejects claims 1-5, 7-8 and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art (hereinafter "APA"), shown in Figure 11 in view of Ray et al. (hereinafter "Ray"), U.S. Patent No. 5,701,008. The rejection is respectfully traversed.

APA and Ray, individually or in combination, fail to disclose or suggest the adhesive over the step portion as a thin layer, the thin layer includes a height that is less than the height of the microlenses, as recited in claims 1, 4, 7 and 10.

The Office Action admits that APA fails to disclose the adhesive over the step portion as a thin layer that includes a height that is less than the height of the micro lenses. However, the Office Action attempts to overcome the admitted deficiency by arguing that Ray discloses the thin layer adhesive. In particular, the Examiner states, on page 4 that "The adhesive filling into the space/gap defined between the surface of the transparent cover (49) and the surface of the substrate having microlenses and the step portion will follow the pattern defined by the two mentioned surfaces and thus the adhesive layer on the gap defined by the step portion and the transparent cover over the sealing material has a height that is less than the height of the microlenses as a result of the protrusion formed on the step portion of the combined product."

However, Applicant respectfully submits that the Examiner's statement above is a broad, conclusionary statement about teachings of two references that do not constitute evidence of proper motivation to combine the references. This statement also equates the prior art teachings with Applicant's teachings and, as such, is evidence of combining the teaching of these two references solely on the basis of improper hindsight reconstruction of Applicant's invention. Accordingly, one would not be motivated to combine the references of APA and Ray absent Applicant's disclosure being used as a template to guide them. Thus, this is an example of improper hindsight reconstruction of the claimed invention.

Further, the Office Action must also demonstrate that modifying one reference in view of another reference is even feasible. Moreover, the case law requires that for motivation to be proper, showing that something is feasible is not enough. Just because something is feasible does not mean that it is desirable or that one of ordinary skill in the art would be motivated to do what is feasible. See Winner International Royalty Corp. v. Wang,

53 USPQ2d 1580 (Fed. Cir. 2000) which points out that motivation to combine references requires a showing not just of feasibility, but also of desirability.

That is, the purpose of the thin adhesive layer in Applicant's invention is that the thin adhesive does not function as a cushion when the first and second substrates are pressed in the peripheral region. However, if one of ordinary skill in the art would have pressed the IR window 10 against the detector substrate in the device of Ray, the sealing seal 8 will clearly contact and support the IR window. In fact, Ray discloses that the height of the solder seal 8 determines the distance between the microlenses and the corresponding detector pixels (col. 4, lines 47-49), which aligns the desired incoming IR radiation onto the pixels.

Further, APA and Ray fail to disclose or suggest a step portion being substantially equal in height to the microlenses throughout a region completely overlapping the sealing material, the width of the step portion being wider than the entire width of the sealing material, and a transparent cover adhered to the lens array substrate with an adhesive that covers the micro lens and the step portion, as recited in claims 1 and 10, and similarly recited in claims 4 and 7.

However, Applicants respectfully traverse this rejection. In particular, the mere fact that parts of prior art disclosures can be combined does not make the combination obvious unless the prior art also contains something to suggest the desirability of the combination. In re Imperato, 486 F.2d 585 (CCPA 1973).

Further, in Tec Air Inc. v. Denso Manufacturing Michigan Inc., 52 USPQ2d 1294 (Fed. Cir. 1999), the Court of Appeals for the Federal Circuit stated that there is no suggestion to combine relevant teachings from different references if a reference teaches away from its combination with another source. The court also stated that a reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Ray with the teachings of APA with any expectation of success without destroying the invention. That is, Ray discloses that the seal 8 can be made from indium, tin, lead solder or vacuum epoxy with the height of the seal precisely determined (col. 3, lines 31-34). However, Applicant's claimed invention discloses a transparent cover adhered to the lens array substrate with an adhesive. Accordingly, by placing the IR window 10 on the seal 8 with the materials stated above, the transparent cover in Applicant's invention would crack or even break because of the hard surface sealing material of Ray and, in all likelihood, would not be adhered as Ray is adhering a metalloid IR window 10.

Accordingly, there is no motivation to modify the disclosure of Ray with the disclosure of APA in the manner asserted by the Office Action, as they have nothing in common other than focusing micro lenses. They operate in different areas of the EM spectrum and are therefore comprises of different of materials requiring different consideration. One would not look to Ray using primarily a metallic material to space a metalloid from a substrate to solve a compressibility problem with resultant distortions found in the APA references. In the absence of any motivation to do so, one of ordinary skill in the art would not have combined the references and then modify the resulting combination as asserted in the Office Action to obtain the claimed invention.

In regards to claims 4-5 and 7-8, the Office Action states, on page 4 that "since the method of manufacturing the device is merely a list of forming each component and each component must be formed to make the device, the method of manufacturing would be inherent to the device." However, Applicant's respectfully submit that inherency requires that what is allegedly inherently disclosed in a reference be necessarily disclosed. Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipated a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized

by persons of ordinary skill.” Cont’l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

For at least these reasons, Applicant respectfully submits that APA and Ray, individually, or in any combination, fail to disclose or render obvious the features recited in independent claims 1, 4, 7 and 10. Claims 2-3, 5, 8 and 11 which depend from the independent claims are likewise distinguished over the applied art for at least the reasons discussed as well as for the additional features they recite. Reconsideration withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-5, 7, 8, 10-11 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

David J. Cho
Registration No. 48,078

JAO:DJC/brc

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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